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09/832,622	04/11/2001	John J. Potenza	SE001U	1826

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DON E. ERICKSON
LAW OFFICES
7668 EL CAMINO REAL STE. 104 #627
CARLSBAD, CA 92009

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,622

Applicant(s)

POTENZA, JOHN J.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-18 and 20-53 is/are pending in the application.
- 4a) Of the above claim(s) 39-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-18 and 20-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on 8/3/04 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Response to Amendment

The amendment filed 4/12/04 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-3, 5-16, 17-18, 20-30, and 31-38, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-3, 5-16, 17-18, 20-30, 31-38 are directed to a "method for providing transactional service information to a service provider", which is not within one of the classes of invention set forth in § 101.

The "method for providing transactional service information to a service provider" comprising the steps of (a)-(c) {claim 1}, steps (a)-(d) {claim 17}, steps (a)-(e) {claim

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31}, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “method for providing transactional service information to a service provider” comprising the steps of (a)-(d) as shown are:

1) merely an abstract idea and

2) does not reduce to a practical application in the technological arts (integration with computer/computer automation) and are therefore are found to be non-statutory.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 112

2. Claims 1-3, 5-16, 17-18, 20-30, 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 17, 31, in step (a), (1) it's not clear the relationship between a single “provider” with plural “providers” and the intended function of each. So there is 1 provider providing the evaluator a unique transaction record and many providers providing the same evaluator above evaluation data? (2) Does evaluation data cover a unique transaction record or they are distinct? (3) It's not clear whether the “evaluation data” from plurality of service providers are the same as the “evaluation data” from the service evaluator. Is this the same data or different data? (4) why there are no

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mentioning of plurality of "service providers" in the remaining parts of the claim, parts (b) and (c).

In claims 1, 17, (5) the preamble calls for "at least one manager, at least one employee" but there are no discussion of the "at least one manager" and "at least one employee" in the body of the claim.

3. Claim 2 recites the limitation "the step of provider manager retrieving the file" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 1 merely recites the intended use of the file.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. **Claims 1-3, 6-11, 13-16, 17-18, 20-25, 27-30, 31-33, 35-38 are rejected under 35 U.S.C. 103(a) as obvious over RIORDAN et al (US Patent 6,519,572) in view of KESEL (US Patent 6,026,387) or further in view of FUERST (US Patent 6,189,029)**

As for Independent Method claims 1, 17, 31, RIORDAN et al fairly discloses a method for providing transactional service information to a service provider comprising the steps of:

(a) the provider providing to an evaluation processor a unique transaction record, and the provider also providing to an evaluation processor evaluation data, {see col. 2, lines 10-25 (or c2:10-25), "captures at the POS all (1) financial data such as invoice and (2) non-financial data pertaining to a specific consumer transaction", Fig. 4, Fig. 6, col.

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10:1-10 ("customers on the basis of distinct parameters, including: residence, ethnicity, family status, income, taxes, vocation, # credit cards held, etc.,"); and

(c) the evaluation processor correlating information from the unique transaction record and the evaluation data to produce a correlated transaction file; and wherein the evaluation processor stores the correlated transaction file for retrieval by the service provider manager. {see c1:25-30, c6:40-50, c7:19-25, c10:1-15, Fig. 1 and Fig. 6}.

Note that RIORDAN et al fairly teaches on c1:20-30 that it's well known that market research firms (or evaluator) are employed to collect data using surveys, questionnaires, and other costly, and time-consuming techniques and therefore, data warehouse (185) in Fig. 1 or 6 would inherently include the market research firms (or evaluator) or would have been obvious for the market research firms to include data warehouse to carry out the same function.

As for the limitation of the evaluator receiving evaluation data from a plurality of providers, mere duplication of step to double the effort or data for whatever intended purpose well known to an artisan, more results which increase accuracy, etc., is well known and would have been obvious to a skilled artisan, absent evidence of unexpected results. In re Hazra, 124 US 378.

RIORDAN et al fairly teaches the claimed invention except for (b). However, on c1:12-38, RIORDAN et al fairly teaches that in the past, Market Research firms collect marketing data by contacting consumer/customers of manufacturer (or provider), retailer and financial institutions, etc. using surveys, questionnaires, and other means to determine consumer behaviour, i.e. buying patterns. Surely, the consumer (or

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customer) has to provide evaluation data to the evaluator about the provider for marketing purpose so they can determine the buying patterns of consumer or sales patterns of provider. Note that RIORDAN et al fairly teaches the replacing of the inefficient manual marketing/surveying step to automatic global computer network automation using the Internet wherein the customer can access the provider via retailer's website {see Fig. 1 or 3, c4:30-40}. The benefits of the Internet are speed, availability, instant, capable of handling large volume of information, non-biased data, etc., which are well known to an artisan. Note that RIORDAN et al also teaches the providing of evaluation data from the provider as shown in step (a) above.

In a similar marketing method for collecting consumer data with respect to sale, KESEL is cited to teach well known concept of consumer providing feedback (or evaluation data) to the evaluator (evaluation processor), the feedback containing a unique transaction identifier of the provider so evaluator can analyze, and report the information back to the provider for evaluation of service provided {see c5:35-65, c6:1-10}. It would have been obvious to modify the teaching of RIORDAN et al by further including a step of providing an evaluation data (consumer feedback about the sale experience) containing a unique transaction identifier of the provider from a service evaluator (consumer/customer) to the evaluator as taught by KESEL to further obtain consumer feedback about the sale experience to completely monitor all of the information regarding consumer sale experience so that evaluator can analyze, and report the information back to the provider for evaluation of service provided. The

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implementation of any well known manual steps to computer automation would have been obvious in view of the automation teaching of RIORDAN et al above.

In a similar marketing method for collecting consumer data with respect to sale, **FUERST** is cited to teach efficient interactive automatic web survey tool builder and result compiler to allow efficient marketing/surveying between customer service provider and customer {see c1:40-60, c2:20-690}. It would have been obvious to modify the marketing/surveying method of RIORDAN et al / KESEL by using web survey to allow the customer (service evaluator) to provide evaluation data to the evaluator as taught by **FUERST** above.

As for dep. claims 2 (of 1), 18 (of 17), and 32 (of 31), which deals with the mode for carrying out step (b) and part of (c), i.e. interactively, this is inherently included in the Internet system of RIORDAN et al. Moreover, this is taught in KESEL c3:1-15 and further in view of the responses by the management to the report (see 3:15-20). Note that the term “interactively” merely means responding back and forth between 2 parties without limitation on time. Moreover, this is taught in **FUERST** in c1:40-50.

As for dep. claims 3, 5, (of 1), which deal with the parameters of the transaction record, i.e. including an ID of the service evaluator (customer), this is taught by RIORDAN et al on Fig. 6, 60, c9:47-57.

As for dep. claims 6 (of 1), 20 (of 17), which deals with the parameters of the transaction record, i.e. including an ID of the at least one service provider management, i.e. employee, this is fairly taught in KESEL Fig. 4, Table 2, on “performance category”, there is a selection for “management” which normally include employee and manager,

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and "attitude: poor" which indicates the attitude of the service provider. Alternatively, the selection of either manager or employee/sale clerk, would have been obvious since these are well known parts of retailer management.

As for dep. claims 7-8, 10 (of 1), 21, 23, 24 (of 17), 33 (of 31), which deals with the file parameter, these are fairly taught in KESEL Fig. 4 or 5 or Table 2 for selected issue and further in view of the rejections of dep. 6, 20 above.

As for dep. claims 9, 11 (of 1), 22, 25 (of 17), which deals with the file parameters, i.e. being retrieved directly to the service provider, this is inherently taught in the Internet system of RIORDAN et al as shown in Fig. 1, 5 and 6. This is also taught in KESEL c2:26-31, c4:45-60, c5:40-60, c10:45-55 (by Internet access) or FUERST c9:20-30, c2:20-68.

As for dep. claims 13 (of 1), 27 (of 17), 35 (of 31), which deals with the means for providing the evaluation data, i.e. inquiry/response system, this is shown in KESEL Figs. 1, element 10 or c5:35-65 or RIORDAN et al Fig. 6.

As for dep. claims 14 (of 1), 28 (of 17), 36 (of 31), which deals with the type of system, i.e. automatic, this is inherently included in the Internet system or inherently in the consumer feedback apparatus of KESEL since it's automated and no manual steps are required.

As for dep. claims 15 (of 1), 29 (of 17), 37(of 31), which deals with accessing type, i.e. by telephone, this is taught in KESEL 11:35-45, 6:37-42.

As for dep. claims 16 (of 1), 30 (of 17), 38 (of 31), which deals with accessing type, i.e. by internet, this is taught in RIORDAN et al Fig. 1.

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5. Dependent claims 12, 26, 34, are rejected under 35 U.S.C. 103(a) as being unpatentable over RIORDAN et al in view of KESEL or FUERST.

As for dep. claims 12, 26, 34, the practice of rewarding the consumer an incentive or reward for replying to the survey is well known in the art. It would have been obvious to modify the process of KESEL by giving incentive/reward to customers who responds to survey or giving feedback for compensation of time and effort involved for responding to the survey which are critical to the success of the company as taught in col. 1, lines 15-67.

6. Dependent Claims 2, 12 (of 1), 18, 26 (of 17), and 32, 34 (of 31) are rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over RIORDAN et al in view of KESEL or FUERST as applied to claims 1, 3, 5-11, 13-16, 17, 20-25, 27-30, 31, 33, 35-38 above, and further in view of REMLER (US 2002/0077906) or FUERST (US 6,189,029).

The teachings of RIORDAN et al/KESEL or FUERST is cited above.

As for dep. claims 2, 18, 32, REMLER is cited to teach interactive survey to improve services and products value, image, responding speed (using Internet) , and consumer desirability (0004). It would have been obvious to modify the process of RIORDAN et al/KESEL or FUERST by using interactive survey as taught by REMLER to improve to improve services and products value, image, responding speed (using Internet), and consumer desirability (0004).

As for dep. claims 12, 26, 34, REMLER is cited to teach well known practice of rewarding incentive to the customer for responding to a survey or giving feedback

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(0017, 0074). It would have been obvious to modify the process of RIORDAN et al /KESEL or FUERST by giving incentive/reward to customers who responds to survey or giving feedback as taught by REMLER above as a means for compensation of time and effort involved for responding to the survey.

Response to Arguments

7. Applicant's arguments with respect to the rejections of claims 1-53 under 35 USC 103 as being obvious over KESEL have been considered but are moot in view of the amendment to claims 1, 17, and 31 and due the new ground(s) of rejection.

8. Applicant's arguments including the minor amendment to the independent claims with respect to the 101 rejections of claims 1-2, 5-18, 20-38 have been fully considered but they are not persuasive in view of the 101 rejections above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (Office action of 12/30/03).

1. US 6,577,504 is cited to teach the use of an automatic inquiry/response system feedback (0017) to improve speed and reduce cost (col. 2, lines 25-35, 50-55) similar to FUERST above.

2. US 5,893,075 is cited to teach the use of an automatic inquiry/response system feedback with incentive to improve speed and reduce cost.

3. NPL: Article 1992 is cited to show well known use of survey to monitor performance of salesperson by conducting survey with respective customer. This is cited here for applicant's awareness and not in the rejection to avoid multiple rejections.

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11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or <http://pair-direct@uspto.gov>

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
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Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn


DEAN T. NGUYEN
PRIMARY EXAMINER